

1 HONORABLE RONALD B. LEIGHTON  
2  
3  
4  
5  
6

7 UNITED STATES DISTRICT COURT  
8 WESTERN DISTRICT OF WASHINGTON  
9 AT TACOMA

10 PERFECT COMPANY,

11 Plaintiff,

12 v.

13 ADAPTICS LIMITED,

Defendant.

CASE NO. C14-5976RBL

ORDER

14 THIS MATTER is before the Court on the Following Motions: Defendant Adaptec's  
15 Motion to Dismiss [Dkt. #110]; Adaptec's Motion to Compel Rule 120 Disclosures [Dkt. #114];  
16 and Adaptec's (second) Motion to Compel [Dkt. #s 150 and 152 (sealed version)]. Adaptec's  
17 Motion to Seal its second Motion to Compel [**Dkt. #148**] is **GRANTED**.

18 Adaptec seeks dismissal of Perfect Co.'s patent infringement claims against it under Fed.  
19 R. Civ. P. 12(c) and 35 U.S.C. § 101, claiming that the '365 patent is invalid because asserts only  
20 un-patentable, non-inventive "abstractions." *Citing Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134  
21 S. Ct. 2347 (2014).

22 Perfect Co. denies that its patent claims only abstractions, and emphasizes that Adaptec  
23 asked the USPTO to re-examine the '365 patent less than a year ago, and the patent's validity  
24

1 was confirmed (indeed, some additional claims were allowed). It also points to Adaptics' heavy  
2 "clear and convincing evidence" burden of proof for invalidity.

3 Adaptics has not met this standard. The Motion to Dismiss based on patent invalidity is

4 **DENIED.**

5  
6 Adaptics' first Motion to Compel seeks additional Rule 120 disclosures. Adaptics claims  
7 Perfect has refused or at least failed to provide required information about its contentions and its  
8 efforts to monetize its invention. It specifically asks Perfect Co. to describe the "real time filling  
9 feature," and seeks an "element by element" mapping of each claim element to each of Perfect  
10 Co.'s products. It also claims that Perfect Co.'s responses to other discovery is insufficient.

11 Perfect Co. claims that the former request properly awaits the (now-completed) claims  
12 construction process, and that the latter is not relevant, and is out of proportion to the needs of  
13 the case. It also points out that such mapping was done in re-examination. It also argues that  
14 Adaptics' claim that Perfect Co.'s infringement contentions were not sufficient comes 17 months  
15 into the case. Finally, and most contentiously, Perfect Co. argues that it needs access to  
16 Adaptics' source code before it can supplement or amend its Rule 120 Contentions, and blames  
17 Adaptics' counsel for the delay in doing so.

18 Adaptics claims Perfect Co.'s attorney improperly seeks to share that code with outside  
19 counsel, and that the delay is Perfect Co.'s fault.

20 The Court is not inclined to get to the bottom of this secondary discovery dispute, and it  
21 is not necessary to do so to resolve the motion. If it has not yet done so, Adaptics will provide its  
22 source code in a manner that is useable to Perfect Co. Perfect Co. shall inspect Adaptics' source  
23 code in a manner consistent with the Stipulated Protective Order, and shall then amend its Rule  
24

1 120 Contentions. This process should be completed within 30 days. To this extent, Adaptics'  
2 first Motion to Compel is GRANTED. Adaptics Motion to compel contentions regarding "real  
3 time" and an element by element mapping is DENIED.

4 Adaptics also seeks Perfect Co.'s licensing information. Perfect Co. claims (and has  
5 demonstrated) that the information is sensitive and subject to the Protective Order and an  
6 "attorneys' eyes only designation." The material will be produced AEO, as Mr. Rylander  
7 describes his offer in Perfect Co.'s Response. [Dkt. # 126 at 9-10]. Adaptics Motion to compel  
8 such licensing information is, to this limited extent, GRANTED.

9 Perfect Co.'s Motion to "Strike, Seal, and Admonish" (in its Response) is DENIED  
10 without prejudice to renew, if the allegedly "cavalier" treatment of confidential information  
11 continues.

12  
13 Adaptics second Motion to Compel seeks a whole new list of documents and information.  
14 Perfect Co. argues that most of the information has been produced and that which has not is not  
15 discoverable or relevant. Adaptics specifically seeks information that "corroborates" Perfect  
16 Co.'s claims. Perfect Co. argues (and demonstrates) that because the date of its invention is not  
17 at issue, corroboration evidence is not relevant. The Motion to produce such corroboration  
18 evidence is DENIED. The Motion to produce documents and other evidence related to inventor  
19 contributions and intervening prior art is DENIED.

20 The Motion to compel market studies supporting Perfect Co.'s claims (on re-  
21 examination) that it has 7000 outlets and Adaptics has less than 400 is DENIED. Similarly  
22 DENIED is the request for additional production of documents relating to Brookstone's  
23 marketing of Perfect Co.'s products. If and to the extent Perfect Co. has not yet produced  
24

1 documents responsive to RFPs 21 and 22 (financials), it shall do so within ten days. The Motion  
2 to Compel is to that extent GRANTED.

7 || \*\*\*

12 | IT IS SO ORDERED.

13 Dated this 6<sup>th</sup> day of November, 2017.

Ronald B. Leighton  
Ronald B. Leighton  
United States District Judge